Be that as it may, the substance of the Office Action rejection is contained entirely with this single line:

> **The applicant mentions that Mori fails to teach an auction type where the bids are treated as mutually exclusive. Rackson teaches this feature and a motivation has been given to combine Mori with Rackson. However, to further expound upon the reasoning**

In other words, the Examiner has rejected all of the claims in light of Mori taken with Rackson under § 103. This is unsupportable for several reasons, and reconsideration is requested.

First, the Examiner appears confused about the state of the present rejections; Rackson was never argued to be applicable to any claim except claim 27; this is identified in the Office Action from Examiner Akers mailed November 10, 2003, page 7:

> **bidders(col 13 lines 30-50) with respect to claim 6.Rackson teaches permitting a bidder to bid on two separate items auctioned in two separate periods through the coordionated bidding mechanism(col 7 lines 18-36)per claim 27.**

Thus, even as of the last rejection in this case, Examiner Akers did not contend that this reference stands for the proposition now advocated by the present Examiner. The reference has now been disproportionately magnified in importance - without any warning - to reject all the claims. This extrapolation is not supported by the record or the reference.

Simply stated, it is has never been demonstrated that Rackson "teaches" a system where bids are treated as mutually exclusive. As pointed out in the last amendment, in Rackson, as can be seen in FIG. 14, the broker only presents a single user bid to a single remote auction system at a time. This is necessary, of course, because otherwise if it were presented to more than one system Rackson has no mechanism for ensuring that the user's bid might be satisfied more than once. This can be confirmed from Rackson at col. 23, ll. 53 – 55. So there is never any "mutually exclusive" bid to resolve.

Consequently, the record does not show anything to date to support the Examiner's current contention. In any event, it is improper for the Examiner to impart a new attribute to Rackson, issue new rejections of claims 1 – 26 and 30 – 120 - based on arguments which have never been presented or considered during the present prosecution - and then declare the action Final.

Finally, the Examiner also errs when he declares that the prior Office Action determined that Rackson teaches the new limitation of claim1 for example added in the last amendment:

> "…. such that the electronic auction determines at most a single item to be awarded to a bidder from said set of ranked bids by correlating a ranking relationship between separate items bid on by such bidder."

Rackson allows two different bids - but only during two different periods. That is all the prior Office Action says at the pertinent areas cited by the Examiner:

> coordinated bidding mechanism. Rackson teaches permitting a bidder to bid on two separate items auctioned in two separate periods through the coordinated bidding mechanism(col 7 lines

Thus, Rackson does not "correlate" anything, let alone a "ranking relationship" between separate items bid on by a bidder, and this fact has never been contested by the PTO. Furthermore, as pointed out in the amendment, Rackson does not even conduct the auction; it merely passes the bids on to separate third party auction sites. So it cannot possibly control the auction, or satisfy a ranking relationship specified by a bidder.

Finally, and this fact cannot be understated, the Applicant finds no hint, let alone mention or suggestion in the references, of the "motivaton" now identified by the Examiner to combine these references, even if everything else above were in fact correct. In other words, the Office action statement here:

> given in the previous Office Action, it would have been obvious for an artisan at the time of the invention to modify Mori to provide multi-bid service as an extension to making single transactions on open networks such as the Internet, wherein the auction process described in Mori may be modified to display a plurality of correlated auction items and/or bidder information as taught by Rackson (see Rackson, col. 8, lines 49+). Thus such a modification would have been considered an obvious expedient well within the ordinary skill in the art.

appears to be crafted and derived entirely from the Examiner's review of the present disclosure. At best it attributes a level of speculation on the knowledge or intent of skilled artisans that is not well supported. This is classic hindsight reconstruction, and should not be used to reject

claims under 35 USC 103. See In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

CONCLUSION

For the reasons set forth above, Applicant requests reconsideration of the present rejections. The new basis raised by the new Examiner is not supported by the record because there is no actual prior rejection of the claims by the prior Examiner based on the reference now relied upon. At a minimum, as noted above, the finality of the Office Action should be withdrawn if the present rejection is going to be maintained, and the record should also be supplemented to include an interview summary as required by MPEP 713.04.

Should the Examiner wish to discuss the present case in person, he is invited to please contact the undersigned at any convenient opportunity.

Respectfully submitted,

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I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to Mail Stop AF, Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450, this 20th day of August 2004.